

REMARKS

Claims 1-13 are amended to place the claims in more proper form to conform to U.S. practice.

Claim 1 is further amended to more clearly pointed out the claimed subject matter. Support for amendment to claim 1 can be found in the specification, for example, at pages 18-21.

New dependent claims 14-17 are added.

Support for claims 14-15 can be found, for example, in original claim 7.

Support for claim 16 can be found, for example, in original claim 9.

Support for claim 17 can be found, for example, in original claim 10.

No new matter is added. Accordingly, Applicants respectfully request entry and consideration of the Amendment.

Upon entry of the Amendment, which is respectfully requested, claims 1-17 will be pending.

I. Drawing

Initially, Applicants wish to point out that drawings (Figs. 1-6) were filed on September 1, 2006 at the time of filing the present application. Applicants request the Examiner to acknowledge the receipt and confirm the acceptance of the drawings.

II. Information Disclosure Statement

The Examiner has initialed the two U.S. patent references listed on the Form PTO/SB/08 submitted with the Information Disclosure Statement (IDS) filed September 1, 2006, thereby confirming that those two references have been considered by the Examiner.

However, the Examiner indicates that copies of four non-U.S. patent references (DE 19631654 and GB 1095056 and two non-patent literature articles) cited in the International

Search Report (ISR) have not been received, and therefore those references have not been considered.

Applicants wish to point out that in normal course of action, the USPTO should have received copies of the references cited in the ISR from the International Bureau. Nevertheless, in an effort to facilitate the prosecution, Applicants submit herewith a supplemental IDS with copies of the four references the Examiner states are missing.

Applicants kindly request the Examiner to consider and attach an initialed and signed copy of the form to the next communication to Applicants.

III. Specification Objection

The specification is objected to because of informalities.

The Examiner suggests that at page 6, lines 6-8, “[T]he method and device of the present invention provide great measurement flexibility and precision, and also make it possible...” should be “[T]he method and device of the present invention provides great measurement flexibility and precision, and also makes it possible....” Further, the Examiner suggests that at page 6 line 16 “[I]n a first way...” should be “[I]n a first embodiment....”

The specification has been amended, accordingly, to correct the noted minor errors. Withdrawal of the objection to the specification is respectfully requested.

IV. Claim Objections

Referring to Section Nos. 3-4 of the Action, claims 4-7 and 11 are objected to as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim. Claims 8-10 are objected to as being in improper form because they depend from a non-considered improperly multiple dependent claim.

As a result of the improper form, the Examiner states that claims 4-11 have not been further examined on the merits.

In response, claims 4-11 have been amended to depend from independent claim 1.

Applicants respectfully request the Examiner to consider claims 4-11 as amended. Claims 4-11 are allowable at least for the same reason with respect to the patentability of independent claim 1, as discussed below.

V. Double Patenting Rejection

Referring to Section No. 6 of the Action, claims 1, 3-4 and 6-12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 7,291,836.

Without acquiescing to the merits of the rejection, to advance prosecution, the common Assignee submits herewith a Terminal Disclaimer, disclaiming the terminal part of the statutory term of any patent granted on the present application which would extend beyond the expiration date of the full statutory term of U.S. Patent No. 7,291,836, to thereby obviate the foregoing rejection.

Withdrawal of the present double patenting rejection is respectfully requested.

VI. Claim Rejections under 35 U.S.C. § 103

Referring to Section No. 8 of the Action, claims 1 and 12-13 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,471,696 (referred to as “Lange” by the Examiner in the Office Action; “Lange”) in view of Tanaka (U.S. Patent Application Publication No. 2002/0129586; “Tanaka”), and further in view of Vitale et al. (U.S. Patent No. 6,294,389; “Vitale”).

Referring to Section No. 11 of the Action, claims 2-3 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lange in view of Tanaka and Vitale, and further in view of Borza et al. (U.S. Patent No. 4,406,778; “Borza”).

Essentially, the Examiner takes the position that Lange discloses the claimed invention, except for the recitations that (1) some of the separated, collected oil is returned to the oil sump, and (2) the results of these measurements are sent to a computer capable of calculating the consumption of lubricating oil not separated in said separation system from these results. Tanaka and Vitale are then relied upon to make up the noted deficiencies of Lange.

Applicants respectfully traverse.

Claims 1 and 12 are independent claims, from which all remaining claims depend, and relate to a method and device for determining oil consumption coming from an oil separation system located in a circuit for recycling blowby gases of an internal combustion engine.

Claim 1 presently recites, in part, steps of subsequently bringing the blowby gases coming from the oil separation system to an oil trapping device located downstream of said oil separation system, whereby the oil not separated from the blowby gases coming from the oil separation system is retained in the oil trapping device; and measuring the radioactivity of the oil retained in the oil trapping device by using a detector, which is placed near the oil trapping device and is sensitive to the ionizing radiation emitted by the radioactive tracer(s).

Claim 12 presently recites, a device for determining the consumption of oil coming from an oil separation system located in a circuit for recycling blowby gases of an internal combustion engine comprising, in part, downstream of the oil separation system, an oil trapping device; a detector sensitive to the ionizing radiation emitted by the radioactive tracer(s), located in the immediate vicinity of the trapping device, so as to measure the radioactivity of the oil not

Separated in the oil separation system but retained in the oil trapping device.

Lange, or the combined disclosure of Lange and other cited references, does not disclose, teach or suggest the claimed configuration, as recited in present claims 1 and 12. Specifically, Lange does not disclose or teach *a trapping device* for trapping the oil not separated from the blowby gases that comes from the oil separation system (2). As such, Lange obviously also fails to disclose or teach measuring the radioactivity of the oil not separated in the oil separation system (2) and retained in the oil trapping device (4) using a detector (3).

As shown in Fig. 1 of Lange, the exhaust gases are brought from engine 10 to diverter valve 18, and then to extraction tower 22 (i.e., the separation system). The gases emitted from the top of the tower (22) are vented to the atmosphere through tube 32. According to Lange (Col. 4, lines 45-52), after the exhaust gas passes through the sodium hydroxide solution from a predetermined period in the extraction tower 22, a sample 42 of the solution is taken from the tower (22) via the drain 36 and is collected *in a sample holder 44*, which is then transferred to a well-type scintillation detector 46 where the radiations are detected and counted.

The Examiner considers the sample holder 44 of Lange is equivalent to the claimed oil trapping device of present application. *See* the Action, at page 5, first paragraph.

Applicants respectfully disagree.

The sample holder 44 of Lange is clearly not an oil trapping device, as required by present claims, because the sample holder 44 of Lange is not capable of trapping and retaining oil from the blowby gases.

In addition, as acknowledged by the Examiner, Lange fails to disclose or teach that some of oil contained within the gasses is separated, collected and returned to an oil sump. However,

Tanaka is relied upon to make up the deficiencies of Lange in this regard. *See* the Action, at page 5, second and third paragraphs.

Applicants submit that there is no motivation to modify the extraction tower 22 of Lange with the oil separator of Tanaka in the manner suggested by the Examiner, as explained below.

Tanaka relates to an oil separator that is suitable for a gas engine for *a gas heat pump type air conditioner*. Tanaka discloses an oil separator for separating oil from a gaseous fluid containing oil in the state of a mist (Abstract).

Tanaka is non-analogous art, as it is not in the field of Applicant's endeavor and not reasonably pertinent to the particular problem with which the Applicant has addressed. Further, Tanaka provides **no** reason for modifying the structure of the extraction tower 22 of Lange. Accordingly, an ordinary skilled in the art would not have been motivated to modify the extraction tower 22 of Lange with the oil separator of Tanaka.

Vitale is cited by the Examiner as teaching that the results of these measurements are sent to a computer capable of calculating the consumption of lubricating oil not separated in said separation system from these results. Vitale does not make up the noted deficiencies of Lange and Tanaka.

In view of the claim amendment and the foregoing remarks, Applicants respectfully submit that the cited prior art references, either alone or taken together do not disclose, teach or suggest all the individual elements as required in independent claims 1 and 12.

Claims 2-11 and 14-17 depend primarily or secondarily from claim 1, thus, those claims are patentable for at least the reasons discussed above with respect to the patentability of independent claim 1.

Claim 13 depends from claim 12, and thus, is patentable for at least the reasons discussed above with respect to the patentability of independent claim 12.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the §103(a) rejection.

VII. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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23373

CUSTOMER NUMBER

Date: February 12, 2010